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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,290	12/11/2000	George Bradley Hobbs	10003973-1	3711

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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

JANVIER, JEAN D

ART UNIT PAPER NUMBER

3622

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/734,290

Applicant(s)

HOBBS, GEORGE BRADLEY

Examiner

Jean Janvier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

***Response to Applicant's 1.131 Declaration***

The Affidavit or Declaration filed on Dec. 20, 2005, under 37 CFR 1.131, has been considered but is ineffective to overcome the prior art reference or the Dutta's Patent 6, 891635B2 filed on Nov. 30, 2000.

The evidence submitted here is insufficient to establish diligence from a date prior to the date of reduction to practice of the prior art reference to either a constructive reduction to practice or an actual reduction to practice.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the prior art reference. While conception is the mental part of the inventive act, **it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another**. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). Here, Exhibits A, submitted by the Applicant in the Declaration, **do not amount to a complete disclosure** and do not indicate any date thereon to thereby show that the Applicant had possession of the invention and was actually the first to invent.

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the prior art reference.

In general, contrary to the Applicant's Declaration, Exhibits A, as submitted by the Applicant in the Declaration, **do not amount to a complete disclosure** and do not indicate any date thereon to thereby show that the Applicant had possession of the invention and was actually

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the first to invent. The disclosure is rather incomplete. Further, although Exhibit B, representing a correspondence between the Attorneys, might show diligence and reduction to practice, however, Exhibit B does not feature the submission of a complete disclosure before Nov. 30, 2000, which is the filing date of the prior art reference. Here, the copy of the Application, with a date preceding the effective filing date of the prior art reference, as submitted by the Attorney to the HP Legal Dept. for review could be used to show the existence of a complete disclosure, reduction to practice and diligence prior to Nov. 30, 2000. In other words, the content of the letter as featured in Exhibit B making reference to the Application is not a substitute for a complete disclosure. Moreover, Exhibit C featuring receipts and billing statements from the Attorney (Dicke Law Firm) to HP Corp. is not a proper or valid disclosure since it does not show any action or activity taken by the Applicant or Inventor (who is concerned here). Additionally, Exhibit D shows no relevant or complete disclosure and is treated the same way. Thus, the 1.131 Affidavit submitted by Applicant to antedate or overcome the prior art rejection is said to be ineffective.

Finally, since the Applicant's attempt to overcome the prior art rejection by "swearing behind" or antedating the reference via the submission of a 1.131 Affidavit has failed and since the Applicant has not challenged the prior art rejection in any other way, it is herein concluded that the Applicant's request to remove or disqualify the reference as prior art has been considered but denied in view of the foregoing response. And the last Office Action, as shown below, is hereby maintained and the current **Action has been made Final.**

#### **Detailed Action**

## **Specification**

### **Status of the claims**

Claims 1-34 have been elected, without traverse, for prosecution on the merits and claims 38-40 are withdrawn from further consideration. Applicant is herein required to cancel claims 38-40 in a future correspondence since the restriction has been made final.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-34 are rejected under 35 USC 102(e) as being anticipated by Dutta, USP 6, 891, 635B2.**

As per claims 1-34, Dutta discloses a method of and a system for providing advertisements in web based printing over a communication network (communication link), such as the Internet. A remote printing web server receives advertisements from one or more advertisers (registering a plurality of advertisements from a plurality of advertisers). The

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advertisements may include target audience attributes, such as the profession of target audience members (advertisers' criteria). Digital advertising images and the target audience information are stored on the remote printing web server (storing the received advertisements in a database coupled to the print processing system). A print user (customer) connects to the remote printing web server, over the network, using a browser. Information about the user (user's profile), such as the user's occupation, is gathered in order to match the user with appropriate advertisements such that targeted advertisements can be presented or displayed to the user, over the network, when the print processing system or the web server processes a print job or print a request for printing submitted by the user. Advertisements are identified and combined with the document that the user wishes to print (presenting or displaying a customized advertisement in the user's document printed by the print processing system). The combined document is then printed on a printer connected to the remote printing web server. In addition, the document that the user wishes to print may be analyzed for document content in order to further select appropriate advertisements to include on the user's printouts or print jobs (presenting or displaying a customized advertisement in the user's document printed by the print processing system or printing web server based on the user's document content) or print job request).

(See abstract; col. 2: 5-32).

The present system deals with providing advertisements in web-based printing. More particularly, the present system deals with providing free or subsidized printing in exchange for advertising space on printed documents (col. 1: 9-14; col. 1: 15 to col. 2: 3).

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Dutta discloses, in general, a system where advertisements can be placed on printouts requested by users of remote printers. Advertisers sign up to advertise to the general public or to particular groups of users. When a user is traveling and needs to print a document on a remote printer (i.e., a hotel, airport, copy service printer, etc.), he is asked for information about his occupation and other personal attributes of the user. This information is used to select advertising that is appropriate to the user. The user requests to print out electronic documents and the selected advertisements are included in the printout (col. 2: 5-39).

FIG. 1 is a network diagram showing the components used in remote web based printing with advertisements. Computer network 100, such as the Internet, is used to connect the various components to one another. Client device 110 such as a portable computer or other pervasive computing device is used as a user print client to connect to computer network 100. A program, such as browser 115 (i.e., Netscape Navigator.TM., Microsoft Explorer.TM., etc.) is used to communicate with other devices connected to computer network 100. **The user of client device 110 may wish to print a document stored on the client device, such as a word processing document or spreadsheet, or may wish to print a document stored on a third party server connected to computer network 110. When the user of client device 110 wishes to print to remote printer 190, he or she interacts with software located on remote printing web server to send print request (print job) 120 through computer network 100 to remote printing web server 170 (print processing system). Remote printing web server 170 receives print request 150, inserts one or more advertisements into the printout and prints the electronic document and the included advertisements onto printer 190 (It is herein understood that the printing web server implicitly supports the step of creating or assigning a job number**

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or ticket number to each print job or print request submitted by a user-col. 3: 3-23; col. 3: 23-59).

Advertisement insertion system 220 of fig. 2 includes four component functions. Advertisement repository puts and removes advertisements in a data storage area accessible by the remote printing web server. The repository also includes information about the intended audience for each advertisement stored in the repository. **Document content type determiner 230 is software for determining the type of document being printed based on keywords found in the document or other attributes of the document (i.e., website from which the document was downloaded, document titles, etc.). Document content type determiner also includes the type of file being printed, such as a spreadsheet, a word processing document, or a web page. User type determiner software 235 determines the type of user that is printing a document (i.e., a doctor, an engineer, an accountant, etc.). This information can be gathered using interactive software that requests the information from the print user before a document is accepted for printing. Advertisement mapping table 240 is an electronic table including advertisement names (i.e., file names or other advertisement identifier) and the types of documents and users that are the target audience for the advertisement (presenting or displaying or inserting one or more targeted advertisements into the user's printed document when the printing web server processes the use's print request based on the user's profile (identification) and the type of document or file format being printed, quality of paper, printing of envelopes including other printing options). The advertising mapping table may also keep track of the number of times each advertisement has been**



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**included in a printout. (All ads displayed into the printed documents are registered ads col. 3: 60 to col. 4: 40).**

Finally, FIG. 6 is a diagram showing the components involved in providing a printed document including registered advertisements. Advertisement insertion system table 600 (see FIG. 2 wherein the table was previously referred to as advertising matching table 240) includes user types (identified user), content types (document being printed) and advertising impressions suitable for the user type/content type. For example, when the user type (user's identification) is a "lawyer" and the document content type is a "spreadsheet" then advertisement #2 is appropriate. When the user type is a "doctor" and the document content type is a "spreadsheet" then advertisements #1 and #3 are appropriate. Finally, when the user type is a "doctor" and the document content type is a "word document" then advertisement #4 and #3 are appropriate. User client type 610 is received from the user's registration information from the user requesting to print. In the example shown, the client type is "doctor." Document type 620 is determined from the document sent for printing; in the example shown the document type is a spreadsheet (file type, file format). Advertisement insertion table 600 is used to determine that, for the example shown, advertisements #1 and #3 should be included with the printout. The advertisement images are retrieved from advertisement repository 630. Selected advertisements 640 are then inserted in the spreadsheet being printed, in this case a pharmacy ad from Advertiser X, and a medical equipment advertisement from Advertiser Z. The modified document (now including the advertising images), is then printed creating printed document 650. Advertisement insertion system table 600 also keeps track of the number of impressions left to be printed. In the example shown, Ad #1 would be decremented from 224 impressions to 223 impressions and Ad #3

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would be decremented from 193 impressions to 192 impressions left to be printed (col. 6: 14-45).

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719.

Official Draft : 571-273-8300

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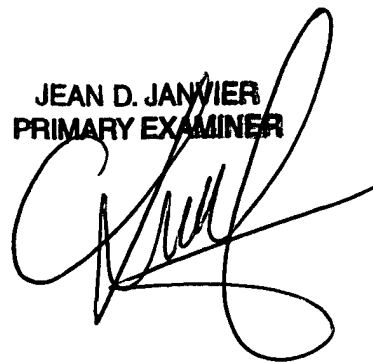
**JDJ**

**Jean D. Janvier**

**Patent Examiner**

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**JEAN D. JANVIER**  
**PRIMARY EXAMINER**

A handwritten signature in black ink, appearing to read 'JDJ', is written over the printed name and title.